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### REMARKS

Claims 1-15 are all of the claims presently pending in the application. Applicant has editorially amended claims 5-9 and 15 for clarity.

Applicant submits that entry of the claim amendments is proper since the amendments do not raise new issues, which would require further consideration and/or search. Furthermore, Applicant did not amend claim 5 in the Amendment filed on August 13, 2008. Accordingly, the Examiner had every opportunity to raise the object to claim 5 in the previous, non-final Office Action dated May 14, 2008.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1 and 4 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 10-14 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gohda (U.S. Publication No. 2002/0154226) in view of Pruett, et al. (U.S. Patent No. 5,778,389; hereinafter "Pruett").

Applicant respectfully traverses these rejections in the following discussion.

#### **I. THE CLAIMED INVENTION**

The claimed invention (e.g., as defined by exemplary claim 1) is directed to a computer-readable storage medium tangibly embodying a program of recordable, computer-readable

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instructions executable by a digital processing apparatus.

The program of recordable, computer-readable instructs the digital processing apparatus to perform, when a file stored in a first folder is selected to be stored into a second folder, comparing a filename of the selected file with a filename of each file already stored in the second folder, if the second folder contains no file having a filename same as the selected file, storing the selected file into the second folder, if the second folder contains a file having a filename same as the selected file, displaying thumbnail images and file information of the selected file and the file having the same filename together on a display device and if the second folder contains a file having a filename same as the selected file, asking a user whether to overwrite the file of the second folder (e.g., see Application at paragraph [0033]).

Accordingly, the claimed invention provides a file transfer program that allows users to easily decide at a glance whether a file should overwrite another file and improves the operability of file transfer in the processing of multimedia files with personal computers.

## II. THE INDEFINITESS REJECTION

The Examiner has rejected claims 1 and 4 under 35 U.S.C. § 112 as allegedly being indefinite. Specifically, the Examiner alleges that claims 1 and 4 recite omnibus claims. The Examiner, however, is clearly incorrect.

That is, claim 1 (and similarly claim 4) recited, "*A computer-readable storage medium tangibly embodying a program of recordable, computer-readable instructions executable by a digital processing apparatus, the program of recordable, computer-readable instructions instructing the digital processing apparatus to perform: ....*"

The claimed invention recites a program tangibly embodied on a computer readable

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medium for performing a method (a computer product). The claim then recites the steps associated with that method. Applicant again points out that this is a common claim (e.g., *Beauregard* claim) format associated with a computer-readable medium.

Applicant again points out that an omnibus claim is a claim including a reference to the description or the drawings without stating explicitly any technical features of the product or process claimed. Indeed, an example of an omnibus claim, as provided in M.P.E.P. § 2173.05, is: A device substantially as shown and described in Figure 1.

Applicant previously explained the definition of an omnibus to the Examiner in the Amendment filed August 13, 2008. The Examiner, however, still appears to misunderstand what qualifies as an omnibus claim.

Claims 1 and 4 clearly do not recite omnibus claims.

However, despite the above understanding, Applicant has amended claims 1 and 4 to clarify the claimed invention.

Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection.

### III. THE STATUTORY SUBJECT MATTER REJECTION

The Examiner has rejected claims 10-14 under 35 U.S.C. § 101 as being directed to a program per se. The Examiner, however, is incorrect.

M.P.E.P. § 2106.01 defines "functional descriptive material." Specifically, "[i]n this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component." (M.P.E.P. § 2106.01).

Applicant respectfully submits that the claimed invention clearly recites a system

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including physical components.

The claimed invention (of claims 1, 4, and 10-14) is not directed to data structures as alleged by the Examiner. Indeed, the definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions" (see M.P.E.P. § 2106.01). The claimed invention of claims 10-14 recites a computer system comprising a plurality of physical components.

Applicant previously submitted the above arguments to the Examiner in the Amendment filed on August 13, 2008. The Examiner, however, failed to address or respond to these arguments (see Response to Arguments at page 9 of the Office Action dated November 14, 2008 where the Examiner indicated that Applicant's arguments are moot). Since the Examiner maintained the current rejection, Applicant's arguments are clearly not moot. If the Examiner wishes to maintain this rejection, then Applicant respectfully requests the Examiner to respond to Applicant's traversal arguments.

Since the Office Action dated November 14, 2008 fails to address Applicant's previous traversal arguments, Applicant maintains the position set forth in the Amendment filed on August 13, 2008, and repeated above.

Furthermore, the Examiner alleges, "Claim 10 does not have any physical devices and relating them to the steps of the claim." (See Office Action dated November 14, 2008 at page 3).

Applicant submits, however, that claim 10 does not recite steps. Indeed, claim 10 recites means-plus-function limitations. Means-plus-function limitations typically do not define the structure of the means performing the claimed function. The structure is found within the specification. Applicant refers the Examiner to M.P.E.P. sections 2181-2184 for

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examining means-plus-function limitations.

Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection.

#### IV. THE PRIOR ART REFERENCES

The Examiner alleges that one of ordinary skill in the art would have combined Gohda with Pruett to render obvious the claimed invention of claims 1-15. Applicant submits, however, that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention.

First, Applicant submits the basis of the prior art rejection in the Office Action dated November 14, 2008 is vague. Indeed, the rejection indicates that claims 1-15 stand rejected based on an alleged combination of Ghoda and Pruett (see Office Action dated November 14, 2008 at page 4). The body of the rejection, however, discusses a third reference to Nelson. Applicant respectfully requests the Examiner to make appropriate corrections.

Applicant respectfully submits that, in rejecting claims 1-15, the Examiner is merely picking and choosing portions of the disclosure of Gohda and Pruett, taken out of context, and attempting to piece together the selected portions to arrive at the claimed invention.

That is, Ghoda is not directed to transferring files from one file to another file. Gohda is merely directed to processing an image, wherein portions of an image are selected and then saved in a file.

The Examiner alleges that one of ordinary skill in the art would have combined the teachings of Pruett with the method of Gohda "to provide an automatic synchronization of directories in order to eliminate inefficient and time-consuming method (*sic*) by using

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standard operating system commands.” (See Office Action dated November 14, 2008 at page 5).

As Applicant pointed out above, however, the method of Gohda is not interested in synchronization of directories. Indeed, the method of Gohda is only concerned with a single directory wherein portions of a moving image file are to be stored.

In general, Applicant respectfully submits that the rejection of record fails to satisfy *KSR's* requirement that “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

Applicant respectfully submits that the rejection of record provides no more than “mere conclusory statements.” Essentially, the method of evaluation in this rejection consists of nothing more than merely:

- Identifying a missing element;
- Describing a feature purportedly inherent in this missing element; and
- Summarily alleging that obviousness results because this inherent feature of this missing element would thereby be provided, in the abstract, by incorporating the missing element.

Applicant submits that this circular reasoning identified above is exactly the type of conclusory statements that the *KSR* holding expressly prohibits and constitutes an improper reasoning mechanism.

Applicant further submits that the underlying fundamental logical flaw in this evaluation approach is that the feature purported to be inherent in this missing element is not realistically related back to the primary reference and that the Examiner’s initial burden is

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not satisfied by simply pointing out features of the missing element, in the abstract, as done in the rejections of record.

Indeed, the rejections of record fail to follow any of the seven rationales now identified in the beginning of MPEP §2143 and previously published by the USPTO in its October 10, 2007, Federal Register Notices, in the aftermath of *KSR*.

Moreover, the alleged Applicant submits that the alleged combination of references does not teach or suggest, *"if the second folder contains a file having a filename same as the selected file, displaying thumbnail images and file information of the selected file and the file having the same filename together on a display device"*, as recited in claim 1, and somewhat similarly recited in claims 5 and 10.

In the claimed invention if the second folder contains a file having a file name that is the same as the selected file, then the system displays thumbnail images and file information of the selected file and the file having the same filename together on a display device.

Gohda (the reference upon which the Examiner relies as allegedly disclosing the above feature of the claimed invention) merely teaches that the processor may display thumbnail images on a monitor (see Gohda at paragraph [0094]). Gohda, however, does not teach or suggest displaying thumbnail images in the context of the claimed invention. Indeed, Gohda does not teach or suggest displaying thumbnail images and file information of the selected file and the file having the same filename together on a display device. Indeed, Gohda does not teach or suggest displaying file thumbnail images and file information together. Furthermore, Gohda does not teach or suggest displaying thumbnail images of the selected file and the file having the same filename together on a display device.

Even if one does not consider the context of the claimed invention, Gohda merely

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teaches displaying a thumbnail image of a file. Gohda does not, however, teach or suggest displaying thumbnail images and file information together.

The claimed invention includes a thumbnail image of the file and file information. For example, in the exemplary, non-limiting embodiment of the invention illustrated in Figure 5 of the application, the file information includes the size of the file and the date the file was last modified. The file information aids a user in determining whether to overwrite the current file in the target folder with the file being transferred.

Gohda, however, does not disclose displaying such information. Indeed, Gohda merely discloses displaying a thumbnail image of a single file (see Gohda at paragraph [0054]).

Furthermore, the claimed invention displays two thumbnails concerning both of the two files having the identical filename stored in the first folder and second folder respectively (e.g., see Application at Figure 5). Gohda, however, does not disclose displaying such thumbnails. Indeed, Gohda merely discloses displaying a thumbnail image of a single file stored in a single directory ("disk D", see Gohda, Fig. 1).

Moreover, the alleged combination of references does not teach or suggest, "*displaying a first frame of the movie as the thumbnail image thereof on the display device, and playing back the movie upon operation to the thumbnail image*", as recited in exemplary claim 2.

The Examiner alleges that Gohda discloses the above feature in paragraph [0053]. This passage of Gohda, however, does not even mention thumbnail images, let alone teach or suggest that the thumbnail image includes a first frame of the movie.

Similarly, the alleged combination of references does not teach or suggest, "*displaying an icon image as the thumbnail image thereof on the display device, the icon image indicating*



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*that the file comprises audio, and playing back the audio upon operation to the icon image*", as recited in exemplary claim 3, and similarly recited in exemplary independent claim 4.

The Examiner alleges that Gohda discloses the above feature in paragraph [0030]. This passage of Gohda, however, does not even mention thumbnail images, let alone teach or suggest that the thumbnail image includes an audio file icon.

Therefore, Applicant submits that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention. Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection.

#### V. FORMAL MATTERS AND CONCLUSION

The Examiner has objected to claim 5. Accordingly, Applicant has amended claim 5 as suggested by the Examiner. Applicant has also amended the preamble of claims 6-9 and 15 to conform to the Examiner's proposed amendment to claim 5.

In view of the foregoing, Applicant submit that claims 1-15, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. Applicant respectfully requests the Examiner to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, Applicant requests the Examiner to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

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The undersigned authorizes the Commissioner to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

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Respectfully Submitted,



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**FACSIMILE TRANSMISSION**

I hereby certify that I am filing this paper via facsimile, to Group Art Unit 2164, at (571) 273-8300, on January 13, 2009.

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